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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,741	07/31/2001	Kazunori Masaki	35.C15637	1261
5514	7590	11/17/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			BLAIR, DOUGLAS B	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2142	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,741

Applicant(s)

MASAKI, KAZUNORI

Examiner

Douglas B. Blair

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/18/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-14, 16-20, 22-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-20, 22-24 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/2006 has been entered.
2. Claims 1-4, 6-14, 16-20, 22-24 and 26 are currently pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-7, 9-14, 16-17, 19-20, 22-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,073,075 to Kondou et al. in view of U.S. Patent Number 6,731,940 to Nagendran.

4. As to claim 1, Kondou teaches a data output system including a plurality of output apparatuses and an accumulating apparatus wherein data stored in an information accumulating apparatuses is output by one of the plurality of output apparatuses, comprising: pursuing unit adapted to pursue a location of a terminal which a user carries (col. 5, lines 6-35, the terminal 10 is pursued by the information server); a data transmission means for selecting information that

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corresponds to location information indicative of the user's location pursued by said pursuing means and transmitting data that has been stored in another of the plurality information accumulating apparatuses from the another information accumulating apparatus to the selected information accumulating apparatus; (col. 6, line 62-col. 7, line 17); and output processing means of transmitting the data transmitted to the information accumulating apparatus by said data transmission means from the information accumulating apparatus to one of the plurality of output apparatuses in accordance with an instruction from the user for output of the data (col. 7, line 28-col. 8, line 3); however, Kondou does not teach a selecting a specific accumulating apparatus to transmit the data to based on the user's position (Kondou generically teaches sending data from the information server).

Nagendran teaches a data transmission unit adapted to select one of the plurality of information accumulating apparatuses that corresponds to location information indicative of the location of the terminal pursued by said pursuing means and transmit data that has been stored in another of the plurality information accumulating apparatuses from the another information accumulating apparatus to the selected information accumulating apparatus if the selected information accumulating apparatus which corresponds to the location information is different from the another information accumulating apparatus which has stored the data (col. 5, lines 31-col. 6, line 11, Nagendran routes the data to the closest base station; the location database is considered one information accumulating apparatus and the base station is considered another); wherein said data transmission means transmits the data from the another information accumulating apparatus to the selected information accumulating apparatus without an instruction from the user for output of the data (col. 5, lines 31-col. 6, line 11).

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5. It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Kondou regarding information accumulation with the teachings of Nagendran regarding the selection of a location specific base station because Kondou discloses the used of mobile radio communications and base stations are commonly used to provide communication for mobile radio communications.

6. As to claim 2, Kondou teaches a data output system according to claim 1, further comprising the provision of: information display means for displaying the data accumulated in the information accumulating apparatuses on the screen of an information processing apparatus used by the user (col. 5, lines 6-35); designating means for designating desired data from among the displayed data (col. 5, lines 6-35); and transmitting means for transmitting the designated data to the information processing apparatus used by the user (col. 5, lines 6-35).

7. As to claim 3, Kondou teaches a data output system according to claim 1, having user designating means for designating the user and wherein in that the information of the degree of importance or urgency is designated in said user designating means (col. 5, line 58-col. 6, line 43).

8. As to claim 4, Kondou teaches a data output system according to claim 1 further comprising said pursuing means specifies the user's location on the basis of location information transmitted by an information processing apparatus used by the user (col. 5, lines 6-35).

9. As to claim 6, Kondou teaches a data output system according to claim 2, further comprising said information display means displays the data name of the data moved to the nearest information accumulating apparatus and addressed to relevant user on the screen of the information processing apparatus used by the user (col. 5, lines 6-35).

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10. As to claim 7, Kondou teaches a data output system according to claim 6, further comprising said output processing means transmits at least one datum selected from among the displayed data to the output apparatus (col. 5, lines 6-35).

11. As to claim 9, Kondou teaches a data output system according to claim 1, further comprising said moving means determines whether the location information has been updated (col. 6, line 47-col. 7, line 21), and selects the information accumulating apparatus corresponding to the location information in conformity with the determination that it has been updated (col. 6, line 47-col. 7, line 21).

12. As to claim 10, Kondou teaches a data output system according to claim 1, further comprising said moving means moves the data when the information accumulating apparatus currently storing the data therein and the information accumulating apparatus corresponding to the location information differ from each other (col. 6, line 47-col. 7, line 21).

13. As to claims 11-14 and 16-17 and 19-20 and 22-24 and 26 they are rejected for the same reasons as claims 1-4 and 6-7 and 9-10.

14. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,073,075 to Kondou et al. in view of U.S. Patent Number 6,731,940 to Nagendran in further view of U.S. Patent Number 6,671,737 to Snowdon et al..

15. As to claim 8, the Kondou-Nagendran combination teaches the data output system of claim 1, however the Kondou-Nagendran combination does not explicitly teach the data being document data with a print apparatus.

Snowdon teaches document data to a node with a print apparatus (col. 13, lines 1-34).

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It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Kondou-Nagendran combination regarding the delivery of data to terminal with changing locations with the teachings of Snowden regarding printing with a mobile apparatus because printing devices are commonly used in networks (Snowdon, col. 1, lines 27-49).

16. As to claim 18, it features the same limitations as claim 8 and is rejected for the same reasons as claim 8.

#### *Response to Arguments*

17. Applicant's arguments filed 9/20/2006 have been fully considered but they are not persuasive. The applicant argues on page 11 of the Remarks filed 9/20/2006 that there are two important features of the applicant's invention: 1) transmitting the data from one server where the data is stored to another server near the user's location without an instruction from the user to transmit the data and without an instruction from the user to output the data, and 2) then outputting the data from the another server to one of a plurality of printers in accordance with an instruction by the user to output the data. Since feature 2 is so important to the applicant's invention, the feature should actually be incorporated into the independent claims. As the claims stand now, only claims 8 and 18 provide any reflection this important feature.

18. On page 13 of the Remarks, the applicant argues that Kondou only includes one server and does not include two servers (i.e. information accumulating apparatuses) where one server transmits data to another server that is selected based on a location. In response, the Examiner points out that the claim language does not require two "servers" but rather claims use the

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broader term "information accumulating apparatuses". The applicant has not shown how the specification limits the term to "information accumulating apparatuses" to "servers" nor can the examiner find any redefinition of this term in the specification. Therefore, the base stations and servers taught by Kondou and Nagendran read on the applicant's claims because base stations and servers are information accumulating apparatuses since the servers transmit information to the base stations based on the terminals location within the wireless network.

19. As to the new limitation involving transmitting data without an instruction from the user for transmission of the selected information data, this feature is shown by Kondou and Nagendran and is inherent to any wireless network. For example, Kondou never requires the user to control the wireless handoff from base station to base station and likewise, no other wireless system requires the user to control the handoff. Handoffs are performed in wireless networks by the wireless system to provide a user with seamless performance without the user having to supply any instructions.

20. As previously suggested, the applicant needs to amend the claims to clearly point out the inventive concept and how it relates to a print system and not just a generic wireless network. If the applicant has any questions or needs any guidance in amending the claim language, the Examiner would be more than willing to help the applicant in order to further prosecution. The examiner can be reached at 571-272-3893.



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***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

DBB



ANDREW CALDWELL  
PRIMARY PATENT EXAMINER